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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,557	09/22/2003	John H. Sohl III	36507-193187	5540
26694	7590	09/19/2008	EXAMINER	
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998		FISHER, PAUL R		
		ART UNIT		PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/666,557	SOHL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	PAUL R. FISHER	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 September 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/14/2004, 4/19/2006, 8/28/2006, 2/7/2007,</u><br><u>1/22/2008</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |



**DETAILED ACTION**

1. This communication is a first Office Action Non-Final rejection on the merits.

Claims 1-26, as originally filed, are currently pending and have been considered below.

***Double Patenting***

2. Claims 7-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,058,509 in view of Kay Marie Ainsley et al.: ““Franchise Fee” Made Simple” (April 22, 2002) hereafter Ainsley. Claims 7-26 are similar if not identical to the originally filed claims 1-20 of U.S. Patent No. 7,058,509.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the preamble of claim 1, recites “equipping and training licensed operators...”, however no such step has been carried out in the claim.

6. In claim 1, the recited term “smart data” renders the claim indefinite. The Examiner is unclear how “smart data” is different the regular data. For purposes of examination the Examiner is taking them to be equivalent.
7. Furthermore, claim 1 recites that “at least one of the steps”, which renders the dependent claims indefinite since relied upon claim limitations may not be present in the method of claim 1. For example if only step a) was performed claims 2-6 would be relying on subject matter not necessary or essential to the claim.
8. In claim 6, it is unclear if the limitation is further defining claim 1 part c) or is a new step to replace part c) or a new step all together. For purposes of examination the Examiner is reading the limitation to be further limiting part c) of claim 1.
9. Claims 2-26, due to their dependency on claim 1, are rejected under the same rationale.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-26 are rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office’s guidance to examiner is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-26 are non-statutory since they may be performed within the human mind.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay Marie Ainsley et al.: “"Franchise Fee" Made Simple” (April 22, 2002) hereafter Ainsley.**

**As per claim 1**, Ainsley discloses a method of equipping and training licensed operators to perform sensor data acquisition at remote locations using a smart data system comprising at least one of the steps of:

- a) charging a licensed operator a one-time setup fee to obtain a license to provide sensor data acquisition services and to obtain training (Page 1, first paragraph after answer; discloses that there is a joining fee or setup fee for becoming a member also known as a “franchise fee”. Page 2, first set of bullets; discloses that for the initial fee it is known for the franchisor to provide training, information, and assistance);
- b) charging the licensed operator an ongoing subscription fee for access to and use of a smart data analysis system for transmission of data and data warehousing services (Page 1, second paragraph after answer; discloses there is also a royalty fee which is a subscription fee to continue receiving services); and
- c) charging the licensed operator an individual project fee, wherein said individual project fee varies according to the amount of analytics, display and customer deliverables required (Page 2, second set of bullets; discloses that each operator or franchisee will be expected to purchase inventory, supplies and insurance at an additional cost).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the franchising system provided by Ainsley with any industry that provides a service. The Examiner asserts that the differences between Ainsley and the disclosed invention would have been easily interchangeable to one having ordinary skill in the art since Ainsley and the disclosed invention are both

directed to a method of charging a fee to obtain a license to perform a specific task.

The type of task adds little, if anything, to the claim, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same regardless of the task performed after the acquisition of the license.

The type of services is considered non-functional descriptive material since it does not alter or change the process in anyway. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the type of services being charged for adds little, if anything, to the claimed steps of the method and thus does not serve as

limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that “nonfunctional descriptive material” is material “that cannot exhibit any functional interrelationship with the way the steps are preformed”. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the information stored in the database does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

**Note:** The Examiner asserts that while limitations a), b), and c) were found only one limitation was required by the current set of claims. For example since claim 1 recites that at least one of the steps, the Examiner could have easily chosen only step a), to fulfill the claim requirement.

**As per claim 2,** The Examiner notes that claim 1 fails to positively recite let along disclose the step of "transmission of said data", i.e. transmitting said data. Since no transmission of data has taken place claim 1 can not be further limited by the limitation found within claim 2, specifically "transmitting said data via a software link to a Web site".

Further still, Step b) discloses, "...charging the licensed operator an ongoing subscription fee," However, what the fee is **for** is not considered a positive recitation of an actual step , but rather non-functional descriptive material, and as such is given little if any patentable weight. In other words, the Examiner considers this to be non-

functional descriptive subject matter because the type of services performed fails to change or alter the step or process as a whole.

Furthermore claim 1, recites that only one step is required. Consequently, if only step a) was performed, step b) would have never been performed and thus can not be further defined by the limitations found in claim 2.

**As per claim 3,** The Examiner notes that claim 1 fails to positively recite let along disclose the step of "smart data analysis", i.e. data analysis. Since no analysis of data has taken place claim 1 can not be further limited by the limitation found within claim 3, specifically "using computational software comprising at least one of: 2D visualization and 3D visualization of geo-referenced direct reading sensor data".

Further still, Step b) discloses, "...charging the licensed operator an ongoing subscription fee, " However, what the fee is **for** is not considered a positive recitation of an actual step , but rather non-functional descriptive material, and as such is given little if any patentable weight. In other words, the Examiner considers this to be non-functional descriptive subject matter because the type of services performed fails to change or alter the step or process as a whole.

Furthermore claim 1, recites that only one step is required. Consequently, if only step a) was performed, step b) would have never been performed and thus can not be further defined by the limitations found in claim 3.

**As per claim 4,** The Examiner notes that claim 1 fails to positively recite let along disclose the step of "smart data analysis", i.e. data analysis. Since no analysis of data has taken place claim 1 can not be further limited by the limitation found within

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claim 4, specifically "aggregating said data into a comparative database providing the user with relative analysis of various sites based on geological and contaminant conditions".

Further still, Step b) discloses, "...charging the licensed operator an ongoing subscription fee, " However, what the fee is **for** is not considered a positive recitation of an actual step , but rather non-functional descriptive material, and as such is given little if any patentable weight. In other words, the Examiner considers this to be non-functional descriptive subject matter because the type of services performed fails to change or alter the step or process as a whole.

Furthermore claim 1, recites that only one step is required. Consequently, if only step a) was performed, step b) would have never been performed and thus can not be further defined by the limitations found in claim 4.

**As per claim 5,** The Examiner notes that claim 1 fails to positively recite let along disclose the step of "data warehousing services", i.e. data warehousing. Since no warehousing of data has taken place claim 1 can not be further limited by the limitation found within claim 5, specifically "posting and delivering at least one of: an interactive two-dimensional visualization; an interactive three-dimensional visualization; and engineering design data; to a Web site".

Further still, Step b) discloses, "...charging the licensed operator an ongoing subscription fee, " However, what the fee is **for** is not considered a positive recitation of an actual step , but rather non-functional descriptive material, and as such is given little if any patentable weight. In other words, the Examiner considers this to be non-

functional descriptive subject matter because the type of services performed fails to change or alter the step or process as a whole.

Furthermore claim 1, recites that only one step is required. Consequently, if only step a) was performed, step b) would have never been performed and thus can not be further defined by the limitations found in claim 5.

**As per claim 6,** Ainsley discloses delivery of software and paper deliverables for each of said projects for each of said projects to at least one of: the licensed operator; and other clients with licensed access (Page 2, first set of bullets; discloses that computer software and paper deliverables are given. Page 2, seconds set of bullets; discloses plan-o-grams and other deliverables such as inventory, supplies, and insurance are also delivered, from this it is shown that the franchisee is given deliverables in exchange for payment).

Furthermore claim 1, recites that only one step is required. Consequently, if only step a) was performed, step c) would have never been performed and thus can not be further defined by the limitations found in claim 6.

**As per claim 7,** The Examiner notes that claim 1 fails to positively recite let along disclose the step of "sensor data acquisition services", i.e. data acquisition. Since no acquisition of data has taken place claim 1 can not be further limited by the limitation found within claim 7, specifically "a) acquiring environmental subsurface data via direct reading sensors; b) geo-referencing said data; c) transmitting said data to a data analysis application server; and d) analyzing said data to obtain information about said data".

Further still, Steps a), b), c) disclose, "...charging a licensed operator a one-time setup fee," "...charging the licensed operator an ongoing subscription fee, " and "...charging the licensed operator an individual project fee". However, what the fee is **for** is not considered a positive recitation of an actual step, but rather non-functional descriptive material, and as such is given little if any patentable weight. In other words, the Examiner considers this to be non-functional descriptive subject matter because the type of services performed fails to change or alter the step or process as a whole.

Furthermore, the type of data itself is considered to be non-function descriptive material since it does not change or alter the method as claimed.

**As per claims 8, 9, 12, 13, and 14,** the type of data is considered to be non-function descriptive material since it does not change or alter the method as claimed. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the

substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the type of data being stored or acquired adds little, if anything, to the claimed steps of the method and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are preformed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the information stored in the database does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

**As per claim 8-26,** The Examiner notes that claim 1 fails to positively recite let along disclose the step of "sensor data acquisition services", i.e. data acquisition. Since no acquisition of data has taken place claim 1 can not be further limited by the limitation found within claim 7, specifically "a) acquiring environmental subsurface data via direct reading sensors; b) geo-referencing said data; c) transmitting said data to a data analysis application server; and d) analyzing said data to obtain information about said data".

Further still, Steps a), b), c) disclose,"...charging a licensed operator a one-time setup fee,", "...charging the licensed operator an ongoing subscription fee, " and "...charging the licensed operator an individual project fee". However, what the fee is **for** is not considered a positive recitation of an actual step, but rather non-functional descriptive material, and as such is given little if any patentable weight. In other words, the Examiner considers this to be non-functional descriptive subject matter because the type of services performed fails to change or alter the step or process as a whole.

Since claim 7 relies on limitations not positively recited in claim 1, it fails to further limit claim 1 and thus any claim dependent on claim 7 also fails to limit claim 1.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689